



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/428,387	10/28/1999	ADAM MICHAEL FENNE	17954-15	4586

7590 07/09/2004

JOEL D VOELZKE  
HOWREY SIMON ARNOLD & WHITE LLP  
301 RAVENSWOOD AVENUE BOX NO.34  
MENLO PARK, CA 94025

EXAMINER
----------

VU, NGOC K

ART UNIT	PAPER NUMBER
----------	--------------

2611

DATE MAILED: 07/09/2004

18

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/428,387

**Applicant(s)**

FENNE, ADAM MICHAEL

**Examiner**

Ngoc K. Vu

**Art Unit**

2611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 May 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 19 and 43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 19 and 43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

***Response to Amendment***

1. Applicant's amendment filed 5/20/2004 has been fully considered. The finality of the rejection of the Office action mailed 1/28/04 is hereby withdrawn, in view of the Hendricks reference and the newly discovered Zigmond reference.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 43 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claim 43 recites the limitations "the delivered message" in line 4 and "pre-cached message" in line 7. There are insufficient antecedent basis for these limitations in the claims. For purpose of examination, the term "the delivered messaged" is interpreted as "the delivered sponsored message", and the term "the pre-cached message" is interpreted as "the pre-cached sponsored message". Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 19 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hendricks (US 6,463,585 B1) in view of Zigmond et al. (US 6,698,020 B1).

Regarding claim **19**, Hendricks discloses an Internet message delivery method (program delivery system 200 communicates with subscribers using an Internet 120 – see col. 9, lines 48-50 and figure 1), comprising:

one or more viewing stations (220), wherein said viewing station further comprises a personal computer operatively connected to the Internet (the set top terminal 220 may connect to the Internet via a separate processor, such as a stand alone personal computer – see col. 65, lines 8-16);

delivering viewing behavior information of a first viewer from one or more viewing stations which the first viewer is using to a processing system (providing a network controller 214 or cable headend 208 a particular viewer access history and viewing habits – see col. 13, line 60 to col. 14, line 45; col. 70, lines 20-25), wherein the processing system (214) and the viewing station (220) are operatively connected to each other through the Internet (see figure 1);

delivering demographic information regarding the first viewer to the processing system (providing the network controller 214 or cable headend 208 a particular viewer demographic information – see col. 70, lines 20-25);

delivering viewing behavior information of a second viewer from one or more viewing stations which the second viewer is using to the processing system (providing the network controller 214 or cable headend 208 a particular viewer access history and viewing habits - see col. 13, line 60 to col. 14, line 45; col. 70, lines 20-25);

delivering demographic information regarding the second viewer to the processing system (proving the network controller 214 or cable headend 208 a particular viewer demographic information – see col. 13, line 60 to col. 14, line 45; col. 70, lines 20-25);

processing the first viewer viewing behavior information and demographic information regarding the first viewer delivered to the processing system to select a first viewer multimedia

Art Unit: 2611

message targeted to the first viewer (generating the advertisements towards particular viewers and makes use of a viewer's demographic information and viewing habits to determine the advertisement that are of most interest to that particular viewer - see col. 66, lines 16-66; col. 67, lines 1-4; col. 68, lines 48-55; col. 69, lines 61-67 and col. 74, lines 62-67);

processing the second viewer viewing behavior information and demographic information regarding the second viewer delivered to the processing system to select a second viewer multimedia message targeted to the second viewer generating the advertisements towards particular viewers and makes use of a viewer's demographic information and viewing habits to determine the advertisement that are of most interest to that particular viewer. It is noted that the advertisements targeted towards individual viewer or groups of viewers - see col. 66, lines 16-66; col. 67, lines 1-4; col. 68, lines 48-55; col. 69, lines 61-67 and col. 74, lines 62-67); and

delivering the first viewer multimedia message to a viewing station of the first viewer (delivering the targeted advertisement to the particular viewer - col. 68, lines 48-55; col. 69, lines 61-67; col. 72, lines 46-51), presenting the first viewer multimedia messages when there is a break in the availability of the multimedia content for presentation at the viewing station (displaying the targeted advertisement or advertisements for displaying on the particular subscriber's television during program breaks – see col. 73, lines 27-35; col. 27, lines 18-28; col. 39-45).

Hendricks disclose not explicitly disclose logging in the viewers from one or more viewing stations. However, Zigmond discloses identifying the viewer or viewers including a login screen or protocol, which requires the viewer or viewers to identify themselves each time video programming is watched (see col. 9, line 56 to col. 10, line 3). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the

Art Unit: 2611

system of Hendricks by including logging feature as disclosed by Zigmond in order to identify the current viewer.

Regarding claim 43, Hendricks discloses a presentation delivery method, comprising:

delivering a sponsored message over the Internet to a viewing station (220) (delivering an targeted advertisement to a viewer station 220 over an Internet – see col. 79, lines 12-14);

delivering multimedia content over the Internet to the viewing station (delivering the local programming or television programming to the viewer station 220 over the Internet – see col. 32, lines 65-67; col. 59, lines 11-14; col. 13, lines 36-52 and figure 1);

presenting the delivered multimedia content at the viewing station (presenting the television program at the set top terminal 220 - see col. 15, line 55 to col. 16, line 2); and

presenting the sponsored message at a time when the multimedia content is at least substantially not available, wherein the multimedia content is not available because a break in the delivering of the multimedia content (displaying the targeted advertisement or advertisements for displaying on the particular subscriber's television during program breaks – see col. 73, lines 27-35; col. 27, lines 18-28; col. 39-45).

Hendricks does not explicitly disclose pre-caching the sponsored message or advertisement at the viewing station. Official Notice is taken that pre-caching or pre-loading data is commonly used in the art. It would have been obvious to one of ordinary skill in the art to modify Hendricks by pre-caching or pre-loading advertisements to minimize the traffic flow in the communication network to thereby efficiently provide the desired advertisements to the user.

Hendricks disclose not explicitly disclose logging in by the viewer to the viewing station. However, Zigmond discloses identifying the viewer or viewers including a login screen or protocol, which requires the viewer or viewers to identify themselves each time video

Art Unit: 2611

programming is watched (see col. 9, line 56 to col. 10, line 3). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Hendricks by including logging feature as disclosed by Zigmond in order to identify the current viewer.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ngoc K. Vu whose telephone number is 703-306-5976. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on 703-305-4380. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**VIVEK SRIVASTAVA  
PRIMARY EXAMINER**

NV  
June 23, 2004